

5.3 INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 04-Apr-05
TO: EXAMINER SENFİ, BEHROOZ
FROM: Jefferson, Henry
PARALEGAL SPECIALIST

APPL. S.N.: 09/752,741
ART UNIT: 2613

RETURN THIS MEMO TO:

Case Drop-Off Location

JEF-2D68

SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 28-Mar-05

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. **THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE.** When your action is complete, please initial, date and return this memo to me. THANK YOU.

The T.D. is PROPER and has been recorded (see ¶14.23).

The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):

The TD fee of [REDACTED] has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).

The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶ 14.26 & 14.26.01).

The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see ¶ 14.27.01).

The T.D. is directed to a particular claim(s), which is not acceptable since “the disclaimer must be for a terminal portion of the term of the entire patent to be granted” (MPEP 1490) (see ¶¶ 14.26 & 14.26.02).

The person who signed the T.D.:

is not an attorney “of record” (see ¶¶ 14.29 and 14.29.01).

has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).

is not recognized as an officer of the assignee (see ¶¶ 14.29 & possible 14.29.02).

No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).

The T.D. is not signed (see ¶¶ 14.26 & 14.26.03).

The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).

The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed) is missing or incorrect (see ¶¶ 14.26, 14.27.02 or 14.26.05).

The period disclaimed is incorrect or not specified (see ¶¶ 14.26, 14.27.02 or 14.26.03).

Other: [REDACTED]

Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and **do not** check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials:

Date: _____

Log Date:

Ex. Initials: _____

Date: _____

Special Program Database, Version 2.1

(Rev. 5/98)

Routing Slip Printed On:

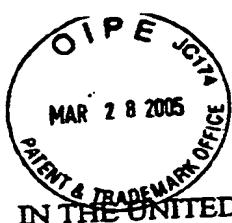
Monday, April 30, 2000 • 11:00 A.M.

Application Number 	Application No. 09/752,741	Applicant(s) SUGIMOTO ET AL.

TERMINAL DISCLAIMER	<input checked="" type="checkbox"/> APPROVED	<input type="checkbox"/> DISAPPROVED
Document Code - DISQ	This patent is subject to a Terminal Disclaimer	
INTERNAL DOCUMENT – DO NOT MAIL		

U.S. Patent and Trademark Office

P20188.A06



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Hideo SUGIMOTO et al.

Group Art Unit: 2613

Appn. No. : 09/752,741

Examiner: B. Senfi

Filed : January 3, 2001

For : ELECTRONIC ENDOSCOPE SELECTOR AND ELECTRONIC
005 M6EBREM1 00000039 09752741 ENDOSCOPE SYSTEM

814 130.00 OP

TERMINAL DISCLAIMER

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop _____
Randolph Building
401 Dulany Street
Alexandria VA 22314

Sir:

Your petitioner, PENTAX Corporation by a concurrently filed name change from Asahi Kogaku Kogyo Kabushiki Kaisha, a corporation of the State of Japan, whose business address is 36-9, Maenicho 2- Chome, Itabashi-Ku, Tokyo, Japan, represents that it is the owner of record of the entire right, title and interest of the above-identified application by virtue of an assignment recorded in the U.S. Patent and Trademark Office on January 3, 2001 at Reel 011418, Frame 0297 of U.S. Application No. 09/752,741 for Electronic Endoscope Selector and Electronic Endoscope System.

The undersigned representative is authorized to act on behalf of the assignee, and it is certified that to the best of the undersigned's knowledge and belief, title is in the assignee.

Your petitioner, PENTAX Corporation, hereby disclaims, except as provided below, the terminal part of any patent granted on the above-identified application which

P20188.A06

would extend beyond the expiration date of U.S. Patent No. 6,717,609, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to United States Patent No. 6,717,609, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above identified application prior to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 as presently shortened by any terminal disclaimer of Patent No. 6,717,609 in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims canceled by a reexamination certificate, is reissued, or is otherwise terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the failure of common ownership stated above.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

By

Name Zenichi OHKURA

Title Director

Z. Ohkura
18. Feb, 2005

February 8, 2005
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191